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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,521	09/10/1999	NAOYUKI MATSUMOTO	35.G0708C/D2	4346

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EXAMINER
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NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/394,521

Applicant(s)

MATSUMOTO, NAOYUKI

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on August 26, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/394,521 is acceptable and a CPA has been established. An action on the CPA follows.

Applicant amends claim 25.

### ***Response to Applicant's Remarks***

2. Applicant remarks that Kita does not teach or suggest notifying the personal computer 8 of information regarding the ability of the communication partner based on the protocol information received from the communication partner through the telephone line 4a. Shimotono does not teach or suggest that the communication adaptor device 2 notifies the computer 3 of the information regarding the ability of the communication partner based on the protocol information (for example, DIS in Fig.4).

Kita teaches that the device 1 can transmit and receive fax information under the control of the personal computer 8 when it is ON LINE control. Thus, when the device 1 receives fax information it has to transmit them to the computer 8 since the computer controls the device 1 to receive the fax information. Thus, the computer 8 has to know the ability of the communication partner in order to set the device 1 to receive and print the fax image. It was commonly known in the art that the protocol information exchanging during handshaking process includes the ability of the communication partner. Shimotono supports that well known in the prior art by

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disclosing a communication adapter device for use in facsimile device which connects a remote facsimile device with a computer wherein when receiving protocol information from a remote facsimile device 5 such as DCS, the communication adaptor device 2 send it to the computer 3 in a page property relating to the ability of the remote facsimile device 5.

3. Applicant remarks that Kita and Shimotono fail to teach that the notification step notifies the host computer of information about a model type and a model version of the data processing apparatus.

As state above, Shimotono teaches the receiving of DSC signals from the remote facsimile device 5 wherein the DSC includes information of the ability of the remote facsimile device 5. It was well known in the prior art that the ability of the remote facsimile machine includes a model type or model version of the data processing apparatus. Anderton et al supports that well known in the prior art by teaching that the DSC signals comprise modem type, modem speed, TS type, modem parameters, facsimile information.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita et al (US Patent No. 5,021,892) in view of Shimotono (US Patent No. 4,964,154).

Concerning claims 25, 26, Kita discloses a data communication apparatus in a data processing system (Fig.3) that includes the data communication apparatus (1) and a host computer (8) connected to the data communication apparatus by an interface (PRL I/F), comprising a communication step of communicating with a communication partner through a network (4a), but without going through the interface; a notification step of notifying, through the interface, the host computer of information regarding the communication partner in accordance with a command from the host computer; a setting step of setting one of an on-line mode, to be operated based on a command from the host computer, and an off-line mode, to be operated even without a command from the host computer; the notification step notifies the host computer in a case where the on-line mode is set in the setting step (col. 2, lines 22-59; col. 3, lines 28-68; col. 6, lines 20 – col. 8, line 48; col. 9, line 26 – col. 10, line 14; col. 15, line 42 – col. 16, line 68; col. 21, line 60 – col. 22, line 13).

Kita does not directly mention the communication step of communicating protocol information and document information with a communication partner. However, it was commonly known in the art that in order to have a communication between 2 communication devices, the 2 communication devices have to exchange communication protocol information and document information. Shimotono supports that well known in the art by teaching a communication device for use in facsimile device combined with computer which connects a facsimile devices with each other wherein the communication device 2 communicate with a remote facsimile side 5 and notifies the host computer 3 regarding the communication partner 5 based on protocol information received in the communication step through interface (Figs.3-6, 8; col. 6, line 64 – col. 9, line 63; col. 12, line 36 – col. 13, line 30; col. 14, lines 24-45). From

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Fig.3, after the communication adaptor device 2 receives DCS signals, it sends page property of the remote-side facsimile device 5 to the computer 3. It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of the communication between a communication device 2, a remote facsimile device 5 and a computer 3 in Shimotono to the communication step in Kita since Kita also teaches the communication between a communication device 1, a remote facsimile device and a computer 8.

Concerning claims 27-28, Kita further teaches that the notification step notifies the host computer in accordance with a command from the host computer; and the data communication apparatus is included in a facsimile apparatus (4).

6. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita et al (US Patent No. 5,021,892) in view of Shimotono (US Patent No. 4,964,154) and Anderton et al (US Patent No. 5,243,438)

Concerning claims 29-30, Kita discloses a method of controlling a data processing apparatus in a data processing system having the data processing apparatus and a host computer comprising an instruction reception step and notification step as discussed in claim 25 above.

Kita fails to teach that the notification step notifies the host computer of information about a model type and a model version of the data processing apparatus. Shimotono teaches the communication between a remote facsimile device 5, a communication device 2 and computer 3 (Figs.4-6, 8) wherein the communication device 2 notifies the computer 3 of information about the device of the communication device 2 (col. 6, line 64 – col. 9, line 63; col. 12, line 36 – col. 13, line 30; col. 14, lines 24-45). From Fig.3, after the communication adaptor device 2 receives

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DCS signals, it sends page property of the remote-side facsimile device 5 to the computer 3.

Shimotono does not specifically mention that the information in the DSC signals comprises the model type or model version of the data processing apparatus. However, it was commonly in the art that the information in DCS signals comprises the model type or model version. Anderson supports that well known in the prior art by teaching the DCS signals comprises modem type, modem speed, modem parameters, facsimile information (201, Fig.2; 301, Fig.3; Figs.5-7. col. 6, lines 5-14; col. 8, lines 54-68; col. 10, lines 39-45). It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of the DSC signals in Shimotono comprising model type of the apparatus as taught in Anderton et al to the protocol information received in the communication step in Kita since Kita and Shimotono teaches the communication between a communication device, a remote facsimile device and a computer 8 while Anderson support the well known prior art of the DCS signals comprising the model type of the apparatus.

Concerning claim 31, Kita further teaches that the notification step notifies the host computer in accordance with a command from the host computer; and the data communication apparatus is included in a facsimile apparatus (4).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- a. Faggin et al (US Patent No. 4,578,537) discloses a telecommunication apparatus serving as an interface between a digital computer and an analog communication medium.
- b. Imaizumi et al (US Patent No. 5,200,830) discloses a facsimile apparatus capable of receiving and printing multiple kinds of data in accordance with a predetermined priority order.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2622

AV  
November 13, 2002